



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,423	03/11/2002	Clemente Spehr	8074-3 (P13735 SB/vat)	3308
22150	7590	10/19/2005	EXAMINER	
F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797			YIMAM, HARUN M	
			ART UNIT	PAPER NUMBER
			2611	
DATE MAILED: 10/19/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/980,423

Applicant(s)

SPEHR, CLEMENTE

Examiner

Harun M. Yimam

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 08/12/2002.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claim 17 is vague and indefinite because it is unclear whether the term "case" as used in the phrase "each case" (line 3) represents one of the sound sequence and the picture sequence, or whether the term "case" represents one temporal instance of both the sound sequence and the picture sequence.

The term "preferably" in claim 17 is a relative term, which renders the claim indefinite. The term "preferably" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The term "preferably" implies that the "in parallel" limitation on line 4 of claim 17 is not required by the claim.

Accordingly, for the purpose of advancing prosecution on the merits, Examiner has interpreted the claim 17 to read as "The method as claimed in claim 11, wherein the apparatus is a television and the information of the television signal is stored separately according to sound sequence and picture sequence, and each of the picture and sound sequence is evaluated individually, according to different predetermined criteria for advertising block identification by the identification device."

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "preferably" on lines 5 and 11 in claim 19 is a relative term, which renders the claim indefinite. The term "preferably" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The term "preferably" implies that the limitations "in the form of an external service provider" on line 5 of claim 19 and "information about the duration..." on lines 11-13 of claim 19 are not required by the claim.

Accordingly, for the purpose of advancing prosecution on the merits, Examiner has interpreted the claim 19 to read as "A control box for suppressing the recording and/or reproduction of undesirable program sections, comprising: an input device for

defining undesirable program sections; a receiving device for receiving the first and second signals made available by the identification device and for receiving the replacement program; a signal processing unit for processing the received first and second signals; an output device for controlling the apparatus appertaining to consumer electronics; a transmitting device for transmitting the information with regard to the consumer behavior, in which case the transmitting device can be coupled to the network interface in order to transfer the data."

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 11-16 and 19-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Zigmond (US 6,698,020).

Considering claim 11, Zigmond discloses a method for suppressing the reproduction of undesirable advertisements (column 4, lines 36-52), transmitted by a transmitter (video programming feed 52 in figure 4 is transmitted to display device 58. Therefore, the transmitter is inherently disclosed—column 7, lines 13-25), for an apparatus (display device 58 in figure 4) pertaining to consumer electronics, having the following steps:

definition of the undesirable program sections (conventional pattern of advertisements in a video programming feed—column 8, lines 41-54), which can be identified by a coded identification signal (encoded data in video programming feed—column 7, lines 26-29 and column 8, lines 39-41) which can be received from an online service provider, in particular an Internet service provider, by means of an input device (column 7, lines 6-9 and 16-21);

identification of the start of an undesirable program section, in particular an advertising block (column 8, lines 48-54), and provision of the identification signal (triggering event—column 8, lines 30-54) by an identification device (60 in figure 4 or 80 in figure 5—column 15, lines 52-61) set up for communication with the apparatus appertaining to consumer electronics (see 58 and 60 in figure 4), said apparatus (display device 58 in figure 4) being in a first operating state (displaying the originally transmitted video programming feed—column 4, lines 45-52);

transmission of a corresponding first signal (triggering event—is transmitted to a video switch 68 in figure 3, which is part of the ad insertion device/WebTV box 60—column 8, lines 30-54) to a control box (ad insertion device/WebTV box 60—column 7,

Art Unit: 2611

lines 43-45 and column 8, lines 30-54) which can be connected to the apparatus appertaining to consumer electronics (see 58 and 60 in figure 4);

processing of the first signal in the control box (column 8, lines 48-54);

changeover of the apparatus into a second operating state (displaying the selected/targeted ads—column 7, lines 26-32) by means of a measure effected by the control box in response to the first signal (specified by encoded data in the video programming feed—column 7, lines 26-27);

identification of the end of the undesirable program section, in particular the advertising block, by the identification device (Since the triggering signal appears at a pre-identified period of time before the onset of a subsequent advertisement series and the ad insertion device 80 in figure 5 determines the precise time for inserting a selected advertisement, the end of each advertising block is identified by the ad insertion device 80),

transmission of a corresponding second signal to the control box (the triggering signal appears at a pre-identified period of time before the onset of each subsequent advertisement series—column 15, lines 52-61);

processing of the second signal in the control box (the ad insertion device/ WebTV box 80 in figure 5 determines the precise time for inserting a selected advertisement by processing the transmitted triggering signal—column 15, lines 52-61);

changeover of the apparatus back into the first or third operating state (resume the video programming—column 4, lines 51-52, or continue to display the selected subsequent advertisement—column 10, lines 19-22 and column 17, lines 37-42) by

means of a measure effected by the control box in response to the second signal  
(column 15, lines 52-61);

insertion of a replacement program at least during the validity of the first signal  
on the apparatus appertaining to consumer electronics (column 4, lines 45-52).

As for claim 12, Zigmond discloses the transmission of information with regards  
to the consumer behavior (viewer information—column 11, lines 14-30) of the user of  
the apparatus via a network interface (internet connection) to the online service provider  
(column 4, lines 55-61 and column 10, lines 4-15).

With regards to claim 13, Zigmond discloses the evaluation of the information  
with regards to the consumer behavior of the user of the apparatus at the online service  
provider; and selection of the replacement program in accordance with the evaluation  
(column 4, lines 25-35) and transmission of the replacement program to the apparatus  
by the online service provider (column 7, lines 61-67).

Regarding claim 14, Zigmond discloses buffering of the replacement program  
(selected ads) (the transmitted selected ads are received and stored in a buffer memory  
- advertisement repository—column 15, lines 24-34 and column 16, lines 43-56), in a  
buffer memory (86 in figure 5); and temporally staggered reproduction of the buffered  
replacement program (the delay code embedded in the video programming stream



Art Unit: 2611

temporally staggers the reproduction of the buffered replacement program—column 16, lines 30-43).

Considering claim 15, Zigmond discloses buffering of the replacement program (selected ads) (the transmitted selected ads are received and stored in a buffer memory - advertisement repository—column 15, lines 24-34 and column 16, lines 43-56), in a buffer memory (86 in figure 5); and temporally staggered reproduction of the buffered replacement program (the delay code embedded in the video programming stream temporally staggers the reproduction of the buffered replacement program—column 16, lines 30-43).

As for claim 16, Zigmond discloses buffering of the replacement program : (selected ads) (the transmitted selected ads are received and stored in a buffer memory - advertisement repository—column 15, lines 24-34 and column 16, lines 43-56), in a buffer memory (86 in figure 5); and temporally staggered reproduction of the buffered replacement program (the delay code embedded in the video programming stream temporally staggers the reproduction of the buffered replacement program—column 16, lines 30-43).

Considering claim 19, Zigmond discloses a control box (ad insertion device 60 in figure 3) for suppressing the reproduction of undesirable program sections (column 4, lines 36-52), comprising:

an input device (ad insertion device 83 in figure 3) for defining undesirable program sections (conventional pattern of advertisements in a video programming feed—column 8, lines 41-54);

a receiving device (88 in figure 5) for receiving the first and second signals (pre-identified triggering signals) made available by the identification device for receiving the replacement program (column 15, lines 52-65);

a signal processing unit (88 in figure 5) for processing the received first and second signals (switching decision unit receives and processes the signals to determine the appropriate time to interrupt the display of the video programming stream to insert in its place the selected advertisement for display to the viewer—column 15, lines 52-65);

an output device (90 in figure 5) for controlling the apparatus (display device 58 in figure 4) appertaining to consumer electronics (column 15, lines 52-65);

a transmitting device (61 in figure 4) for transmitting the information with regard to the consumer behavior, in which case the transmitting device can be coupled to the network interface in order to transfer the data (column 9, lines 39-55 and column 17, lines 33-49).

As for claim 20, Zigmond discloses that the control box comprises a buffer memory (86 in figure 5), which is set up for buffer-storing information (selected advertisements) with regards to sections of the currently received transmission or information from the network interface and for outputting it again to the apparatus

appertaining to consumer electronics (column 15, lines 24-34 and column 16, lines 43-56).

With regards to claim 21, Zigmond discloses that the control box (the ad insertion device/ WebTV box 60 in figure 4 coupled to display device 58) has a further receiving device (146 in figure 8, which is similarly coupled to display device 148), with which it is set up for receiving a signal originating from a remote control (150 in figure 8—column 19, lines 10-19) of the apparatus appertaining to consumer electronics (column 18, line 63 – column 19, line 9).

Regarding claim 22, Zigmond discloses that the control box (the ad insertion device/ WebTV box 60 in figure 4 coupled to display device 58) has a further receiving device (146 in figure 8, which is similarly coupled to display device 148), with which it is set up for receiving a signal originating from a remote control (150 in figure 8—column 19, lines 10-19) of the apparatus appertaining to consumer electronics (column 18, line 63 – column 19, line 9).

Considering claim 23, Zigmond discloses that the processing device of the control box is set up for processing the signal of the remote control for the purpose of selection of the second operating state (displaying the cross-over/internet link) of the apparatus (column 18, line 38 – column 19, line 19).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond (US 6,698,020), as applied to claim 11 above, in view of Goldschmidt (US 6,483,987) and further in view of Williams (US 6,184,937).

With regards to claim 17, Zigmond discloses that the apparatus is a television (column 4, lines 37-42) and evaluating a television picture sequence according to predetermined criteria for advertising block identification by the identification device (column 8, lines 48-54).

Zigmond fails to explicitly disclose storing the television information separately according sound and picture sequence, and evaluating said sound sequence for advertising block identification by the identification device.

In analogous art, Goldschmidt discloses evaluating sound sequences for advertising block identification by the identification device (column 5, lines 44-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Zigmond's system to include the evaluation of sound sequence for advertising block identification, as taught by Goldschmidt, for the benefit of increasing the reliability of advertising block identification by providing an alternate means for detecting upcoming advertising block.

Zigmond and Goldschmidt fail to disclose storing the television information separately according sound and picture sequence.

In analogous art, Williams discloses storing the television information separately according sound and picture sequence (column 2, lines 7-10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Zigmond and Goldschmidt to include storing the television information separately according sound and picture sequence, as taught by Williams, for the benefit having an improved retrieval of television signals by easily distinguishing the audio from video to perform various operations.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond (US 6,698,020) in view of Goldschmidt (US 6,483,987).

Regarding claim 18, Zigmond a method for suppressing the reproduction of undesirable advertisements (column 4, lines 36-52). Zigmond further discloses that the home entertainment system has video programming recording capabilities (column 6, lines 45-47).

Zigmond fails to explicitly disclose that a simultaneous recording of a transmission onto the medium of a recording device contains the step of stopping the recording during the transmission time of an undesirable program section and resuming it after the end of said undesirable program section.

In analogous art, Goldschmidt discloses that a simultaneous recording of a transmission onto the medium of a recording device contains the step of stopping the recording during the transmission time of an undesirable program section (commercial) and resuming it after the end of said undesirable program section (column 1, lines 49-64).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Zigmond's system to include simultaneous recording of a transmission onto the medium of a recording device that contains the step of stopping the recording during the transmission time of a commercial and resuming it after the end of said commercial, as taught by Goldschmidt, for the benefit of recording a desired television program without any commercial interruption.


**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harun M. Yimam whose telephone number is 571-272-7260. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HMY

  
**CHRISTOPHER GRANT  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600**